

Application No.: 10/004,732
Amendment Dated: August 16, 2005
Reply to Final Office Action of: June 16, 2005

REMARKS

Upon entry of this Amendment, claims 1, 2, 4-12, 14-20, and 33-36 will be pending in this application. Claims 1, 2, 11, 12, 33, and 35 were amended herein. Claims 3 and 13 were cancelled herein.

Rejections under 35 U.S.C. §102

Claims 1, 3-8, 11, 13-18, 20, 33, and 35 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Kroll et al., US Patent No. 5,257,634.

Claims 2, and 12 are rejected under 35 U.S.C. § 103(c) as being unpatentable over Kroll.

Claims 9 and 19 are rejected under 35 U.S.C. § 103(c) as being unpatentable over Kroll in view of Bush et al. (U.S. Patent No. 5,282,845).

Claims 34 and 36 are rejected under 35 U.S.C. § 103(a) as being patentable over Kroll in view of Borkan et al. (U.S. Patent No. 6,510,347). Applicant traverses these rejections and asserts that they are rendered moot by the claim amendments made above.

Although Applicant does not agree with, or concede the correctness of these rejections, Applicant has amended the independent claims 1, 11, 33, and 35 to specify that the tine elements are formed of a flexible bio-compatible plastic. Applicant therefore respectfully requests that the above rejections be withdrawn in light of the claim amendments made herein.

Applicant also respectfully asserts that the claim amendments render claims 1, 11, 33, and 35 novel and non-obvious and requests notification to that respect.

Newly amended claim 1 specifies that the time elements are formed of a flexible bio-compatible plastic, and does not offer specific examples, as did the original claim 2, which has been amended to retain the exemplary types of flexible bio-compatible plastics.

Applicant notes that the Examiner did not reject claim 2 as anticipated, but did reject it as obvious over Kroll in combination with U.S. Patent No. 5,257,634. The Examiner noted that "Kroll discloses the claimed invention except for wherein the tines of the tine elements are formed of a flexible bio-compatible plastic selected from the group consisting of medical grade polyurethane compounds and silicone rubber compounds" (page 5, number 6). The Examiner goes on to assert that it would have been an obvious matter of design choice to one skilled in the

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art to modify the system and teachings of Kroll to have the tines that are formed of a flexible bio-compatible plastic.

Applicant disagrees with the Examiner and respectfully asserts that modifying the device of Kroll by making the tines of a flexible bio-compatible plastic would render it unsatisfactory for its intended purpose. According to MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

The summary of Kroll states that "[t]he conductive extension members provide an increased effective length of the electrode conductive body portion to provide a catheter electrode structure having a relatively low electrical impedance" (column 1, line 53-56). It is reiterated at column 2, lines 54-57, that "[t]he high effective length of the catheter electrode due to the extension members provides a low impedance electrode to the heart and blood pool when implanted in the right ventricle". It is further stated at column 4, lines 10-13, that "the present invention provides an implantable defibrillation catheter electrode having at least one conductive extension member angularly disposed from the conductive body of the electrode. Because of the increased effective length of the catheter electrode of this invention the catheter conductive body may have a reduced diameter of approximately 1-2 mm".

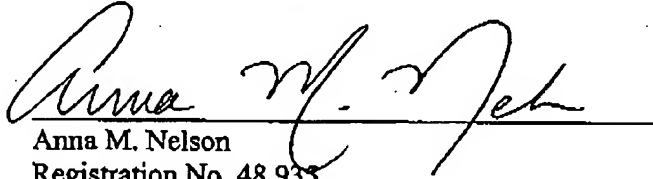
The Examiner's suggested modification, making the tines in Kroll out of a flexible bio-compatible plastic would render the devices of Kroll unsatisfactory for their intended purpose because plastic, which is non-conductive would not increase the effective length of the lead, or give a lower impedance which would allow for a decreased diameter. Because the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no motivation to combine the references, and therefore, neither claims 1, 11, 33, and 35 (nor the claims dependent thereon) are obvious.

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In view of the foregoing amendments, it is believed that the application is now in condition for allowance and notice of same is respectfully requested.

Respectfully submitted,

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